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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,582	09/08/2003	Robin G. Skinner	TEC1216-01	9887
832	7590	01/31/2005	EXAMINER	
BAKER & DANIELS 111 E. WAYNE STREET SUITE 800 FORT WAYNE, IN 46802			TRIEU, THERESA	
		ART UNIT		PAPER NUMBER
				3748

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/657,582	SKINNER, ROBIN G. <i>CD</i>
	Examiner	Art Unit
	Theresa Trieu	3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 November 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11,13-15 and 17-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-11,13-15,17-19 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to the applicants' amendment filed on November 26, 2004.

Claims 4 and 8 have been amended. Claims 12 and 16 have been canceled. Thus, claims 1-11, 13-15 and 17-19 are pending in this application.

The indicated allowability of claims 4 and 8 are withdrawn in view of the newly discovered reference(s) to Tanaka (Publication Number JP 2001-304145) and the finality of that action is withdrawn. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. *Claims 1-3, 5-7, 9-11, 13-15, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka (Publication Number JP 2001-304145).*

Regarding claims 1, 6, 13, 17-19, as shown on Figs. 1 and 5, Tanaka discloses a horizontal compressor assembly for compressing a gas and lubricated with oil, the compressor assembly comprising:

- a hermetic sealed housing (1a) defining a high pressure discharge chamber (8) and low pressure chamber (6a), wherein the bottom portion of the low/high pressure chamber comprises a first/second oil reservoirs (not numbered; however, clearly seen in Fig. 5- 15);

- a compressor mechanism (7) disposed within the housing and defining a working space in which gas is compressed, the compressor mechanism having a first port (7a) in communication with the discharge chamber; the compressor mechanism having a generally horizontally oriented crankshaft; a fixed scroll member (2) and an orbiting scroll member (3) are being mutual engaged wherein the fixed scroll member is sealed against the housing to define the discharge chamber;

- a second port (not numbered; however, clearly seen in Fig. 1) in the discharge chamber (8) defining an outlet in the housing, the second port disposed vertically below the first port (7a) in a lower half of the discharge chamber whereby oil collected (15) and wherein substantially all fluids entering the discharge chamber enter through the first port (7a) and substantially all fluids exiting the discharge chamber exit through the second port (8).

Regarding claims 2, 3, 5, 7, 9, 10, 11, 14 and 15, Tanaka further discloses a valve (not numbered; however, clearly seen in Fig. 5) sealingly engageable with the first port (7a); a discharge tube (12) having an inlet positioned in the discharge chamber (8), the inlet defining the second port; the first port (7a) being located in the fixed scroll member (2); the discharge tube (12) extending through the housing (1a); an inlet opening (11) in communication with the low pressure chamber (6a); low pressure chamber defining an oil sump (not numbered; however, clearly seen in Fig. 5); a motor (6) for driving the compressor mechanism (30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka '145 in view of legal precedent.***

Tanaka discloses the invention as recited above; however, Tanaka fails to disclose a discharge tube being welded to the housing at the flat portion.

Regarding claims 4 and 8, a claim for an article capable of such definition must define the article by its structure and not by the process of making it. Since the claimed flat portion is capable of structural definition, the patentability of the claims must be determined solely on the basis of recited structure, exclusive of process recitations. *In re Johnson*, 394 F.2D 591, 157 USPQ 620, 55 CCPA 1463.

Applicants should also note that where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an obvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed.Cir. 1983). Accordingly, the discharge tube extending through the housing and the housing including a flat portion do not result in any different structure than shown by the applied prior art.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT


Theresa Trieu
Primary Examiner
Art Unit 3748